

REMARKS

Applicants have amended claim 1 to incorporate subject matter recited in claim 27, added new claim 76, and canceled claim 27 without prejudice. An appendix showing the amendment to claim 1 is attached hereto. Claims 7, 11, 13, 15, 17-19, 36-72, 74, and 75 have been withdrawn from consideration as being directed to nonelected claim groups and/or species. Claims 1-76 are pending.

In the Office Action, claims 1-5, 8-10, 12, 14, 21, and 73 were rejected under 35 U.S.C. § 102(b) as being anticipated by DE 2212995 to Schaefer. The Schaefer reference discloses a method and device for the production and output of self-stick labels wherein the labels are on both sides of a backing strip. Applicants have filed herewith an Information Disclosure Statement citing an English-language translation of this German document for the Examiner's consideration.

Claim 1 has been amended to recite: "the backing and the pieces of material being formed from substantially the same material." The Examiner has acknowledged that Schaefer fails to teach or suggest this feature previously recited in claim 27. (Office Action at numbered paragraphs 5-9.) Accordingly, claim 1, as amended, is allowable over Schaefer.

Claims 2-5, 8-10, 12, 14, 21, and 73 depend from claim 1 and are therefore allowable over Schaefer for at least the same reasons as claim 1.

Claim 27 was rejected under 35 U.S.C. § 103 as being unpatentable over Schaefer in view of U.S. Patent No. 5,376,417 to Amano et al., U.S. Patent No. 6,379,761 to Brandt et al., and U.S. Patent 5,569,540 to Hirose et al. As

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

mentioned above, claim 1 has been amended to recite the subject matter of claim 27, which has been canceled.

None of the references cited by the Examiner teaches or suggests a material supply strip, wherein the backing and the pieces of material are formed of substantially the same material, as recited in claim 1. Indeed, the Examiner has acknowledged as much. The Examiner has asserted, however, that it would have been obvious to one of ordinary skill in the art to modify the Schaefer reference in view of Amano et al., Brandt et al., and Hirose et al. to provide a material supply strip with this feature. Applicants respectfully disagree for at least the following reasons.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) based on multiple references, the Examiner must show the following: (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine teachings of the references; (2) there is a reasonable expectation or success; and (3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success are both found in the prior art and not based on applicant's disclosure. See MPEP § 2142.

The rejection applied to canceled claim 27, i.e., to the subject matter now recited in claim 1, fails to establish a *prima facie* case of obviousness. More particularly, the Examiner has not cited any teaching, suggestion, or motivation *in the prior art* to modify the Schaefer reference to arrive at the invention recited in claim 1, as required by 35 U.S.C. § 103(a). Applicants submit, therefore, that claim 1, as amended, is allowable over any combination of the cited references.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

As an initial matter, the Examiner has acknowledged that Schaefer is "silent as to the types of materials used for the labels and backing." (Office Action at numbered paragraph 8.) Although the Examiner relied on the Amano et al. reference for the disclosure of labels made of PET, he admitted that this reference does not disclose any teaching of a material supply strip having pieces of material and a backing formed of substantially the same material. With respect to Brandt et al., the Examiner asserted that this reference discloses backings made of polypropylene and polyester, but he did not cite any disclosure of a material supply strip having pieces of material and a backing formed of substantially the same material. Finally, the Examiner cited Hirose et al. for an alleged teaching of a backing made of polyester or polypropylene (e.g., PET), but once again did not cite any teaching, suggestion, or motivation to provide a material supply strip having pieces of material and a backing formed of substantially the same material. Indeed, Hirose et al. does not even teach a material supply strip having a backing and pieces of material, but rather discloses a thermal transfer sheet for use in thermal transfer printers.

The Examiner's strained attempt to combine the four (4) references addressed above evidences the use of improper hindsight gleaned from the present application. Significantly, the Examiner did not cite any reference that discloses a material supply strip having pieces of material and a backing formed of substantially the same material or any suggestion or motivation to combine one or more references in such a manner. For at least these reasons, Applicants submit that claim 1 is allowable over any combination of the references cited in the rejection of canceled claim 27.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Claim 6 was rejected under 35 U.S.C. § 103 as being unpatentable over Schaefer in view of U.S. Patent No. 5,143,466 to Moncrieff Baldwin et al. Claim 6 depends from claim 1 and is therefore allowable for at least the same reasons as claim 1.

Claims 16, 20, and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schaefer in view of U.S. Patent No. 3,861,986 to Wochner. Claims 16, 20, and 34 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1.

Claims 22, 24-26, and 29-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schaefer in view of Brandt et al. These claims depend from claim 1 and are therefore allowable for at least the same reasons as claim 1.

Claims 23 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schaefer in view of Amano et al. These claims depend from claim 1 and are therefore allowable for at least the same reasons as claim 1.

Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schaefer in view of Brandt et al. and Hirose et al. Claim 28 depends from claim 1 and is therefore allowable for at least the same reasons as claim 1.

New claim 76 recites a "method of applying pieces of material to objects" comprising, *inter alia*, providing a material supply strip with "the pieces of material on the first surface having a different format than the pieces of material on the second surface, wherein the pieces of material on the first surface are positioned on the backing substantially opposite to corresponding pieces of material on the second

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

surface such that outer edges of opposing pieces of material do not line up with one another." None of the cited references teaches or suggests this feature of claim 76.

Claim 76 is supported in the specification, for example, at page 11, lines 2-9. Moreover, this claim reads on the elected claim group (i.e., Group I, a method of applying pieces of material to objects), and the elected species (i.e., B3, each surface of the material supply strip has a different piece of material). Applicants respectfully request that claim 76 be examined and allowed.

Claims 7, 11, 13, 15, 17-19, and 72 were withdrawn from consideration as being directed to non-elected species. Because each of these claims depends from an allowable generic claim, Applicants respectfully request that the Examiner rejoin, examine, and allow each of these claims.

If a telephone conversation might advance prosecution of the application, the Examiner is invited to call Applicants' undersigned attorney at (202) 408-4197.

The Office Action contains characterizations of the invention, the claims, and the related art, with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

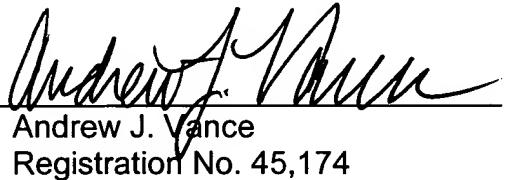
1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17, which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:


Andrew J. Vance
Registration No. 45,174

Date: September 26, 2002

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

APPENDIX

CHANGES TO CLAIM 1

1. (Amended) A method of applying pieces of material to objects, the method comprising:

providing a material supply strip and at least one applicator device capable of applying material from said supply strip to objects, said supply strip initially including a backing having first and second opposing surfaces and pieces of material removably arranged on both of the first and second surfaces, the backing and the pieces of material being formed of substantially the same material;

applying at least one piece of material from the first surface of the backing to at least one object with said at least one applicator device; and

applying at least one piece of material from the second surface of the backing to at least one object with said at least one applicator device.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com